

Appl. No. 09/657,956
Filed 9/8/2000

Atty Docket JP920000170US1

REMARKS

1. Posture of the Case

The case was appealed after a reply to first Office action and a final rejection. No reply brief was issued in response to Applicant's appeal brief. Instead, prosecution was reopened with citation of a new set of art.

The rejection of the broadest claims in the Office action that reopened prosecution relied on Official Notice and a combination of three references, Vatican, Travelocity and Pass. Without amending, Applicant argued in reply that the publication dates of the cited references were not established.

An Office action of April 14, 2004 finally rejected all claims and presented additional evidence or arguments regarding publication dates. In addition, a newly cited fourth reference, USP 6092841 ("Best"), was substituted for Official Notice previously relied upon. Applicant presented procedural reasons as a basis for withdrawal of the finality of the rejection of the Office action and also presented substantive reasons why the invention is patentably distinct over the references relied upon, although Applicant contended not all the references relied upon had been properly established as prior art.

The present Office action is non-final and relies on two new references as the basis for rejection of claims 1, 2, 4, 5, and 7-10, U.S. Patent 5,724,520 ("Goheen") and U.S. Patent 5,432,864 ("Lu"), and additionally on two references that were cited in an earlier one of the Office actions, "De La Rue Gives Singapore the 'Midis' Touch," News Article from De La Rue web site: http://www.delarue.com/dlr_content/cda/pages/news/articles/107/0,1968,,00.html ("De La Rue"), and "USA Travel Agents," from archived web site: <http://web.archive.org/web/19970222052302/www.welcome-to-china.com/mkt/serv/trav/usa.htm> ("Travel Agents"), as the basis for rejection of claims 3 and 6. Applicant herein amends claims 1, 5, 9 and 10 to overcome the rejections.

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2. Applicant's Arguments

A. Claims 1-8

1. The references do not teach or suggest that the pass is for access to the event and not for access to repeated instances of the event.

Claim 1 is herein amended to state that "the pass is for access to the event and not for access to repeated instances of the event." Claim 5 has been amended with similar language, according to the form of the invention it claims. No new matter is added in these amendments, since the specification as originally submitted provides support. That is, in an example given in the present application, an event is the occurrence of the Olympics. Present application, page 4, lines 4. The Olympics is a well-known international, multi-sport event held once each four years. Further, the present application states that the "participants" include the athletes who compete in the Olympic competition events. Present application, page 4, lines 5-10. It is well known that such athletes must qualify for competing in each instance of the Olympic. That is, qualification for a quadrennial Olympic event (i.e., a single instance of an event) does not qualify an athlete/participant to compete (and thereby is not granted an access right) for the event in the next quadrennial. Therefore, it is clear from this example in the present application that the passes are "not for access to repeated instances of the event," as stated in the amended claims.

The cited references do not teach or suggest what is now claimed. The rejection relies upon Goheen for teaching about preparing, issuing and validating a plastic ID card. However, Goheen teaches this ID card is issued as for essentially permanent use, i.e., for repeated instances of flying on a commercial airline, in lieu of boarding passes for respective flights on respective different occasions. Goheen, col. 2, lines 59-60. Applicant finds no suggestion that the "escort memory" Lu discloses is for a pass that is "not for access to repeated instances of an event," as claimed in the present case. To the contrary, Lu teaches that the escort memory may be a magnetic stripe on a credit card. Lu, col. 5, lines 31-33. A credit card is for repeated use.

For this reason, Applicant contends the invention set out in claims 1 and 5 is patentably distinct.

2. Goheen teaches away, and Goheen and Lu do not have a compatible principle of operation.

Claim 1 is herein amended to state that "laminating the pass in a security pouch, wherein the laminated pass includes a photograph of the participant to provide a physical form of

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validation, so that the participant is granted access to the event responsive to identifying the pass in the security pouch as worn by the participant." Claim 5 has been amended with similar language, according to the form of the invention it claims. No new matter is added in these amendments, since the specification as originally submitted provides support. Present application, page 6, line 28 - page 7, line 5.

Claim 1 is also amended herein to state that the validating includes the participant "present[ing] the non-valid pass upon such arrival, or else the issuing to the participant is upon such arrival." Claim 5 has been amended with similar language, according to the form of the invention it claims. No new matter is added in these amendments, since the specification as originally submitted provides support. Present application, page 6, lines 14-21.

The rejection relies upon Goheen for teaching about preparing, issuing and validating a plastic ID card. The teachings of Goheen relied upon for the rejection teach away from what is now claimed, which tends to show the present invention is nonobvious with regard to the cited art. MPEP 2142.02 VI (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). It is significant that *a wearable pass is prepared* in connection with "arrival of such a participant *at, or proximate an event venue,*" as stated in claim 1 (and similarly in claim 5), which includes incorporating the non-valid pass that *the participant presents or is issued at that time*. Although this may be more time consuming than some other manner of validation, such as validation by merely swiping a card in a card reader or showing a badge prepared in advance of an event, these factors tend to balance an interest in speedy validation and a countervailing interest in strong security, and are contrary to the teachings relied upon in the rejection. Goheen teaches that a plastic ID card is mailed to a passenger responsive to an initial reservation. Goheen, col. 2, lines 51-57.

In a related matter, the teachings from Goheen and Lu relied upon for the rejection do not have a compatible principle of operation. If a combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Goheen teaches about avoiding the "paper problem" and seeks to avoid waiting in lines. Goheen, col. 2, lines 1-10. The rejection relies upon teaching by Goheen about preparing, issuing and validating a plastic ID card.

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Goheen also teaches that the ID card is mailed in advance for a first use, and thereafter is retained by the customer to use "again and again." Goheen, col. 2, lines 55-60. Likewise, Goheen's teaches that validation for a particular event (airline flight) is done by merely swiping the ID card in a card reader. Goheen, col. 2, lines 64-66; col. 3, lines 14-21. In contrast, the rejection relies upon teaching by Lu about using a verification station as a card writer. Lu col. 10, lines 1-16. This is incompatible with the relied upon teachings of Goheen. For these additional reasons, Applicant contends the invention set out in claims 1 and 5 is patentably distinct.

3. Dependent Claims

In addition to the above, claims 2-4, 6-8, and 9-10 are allowable at least because they depend on respectively allowable independent claims. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)).

B. Claims 9 and 10

1. The references do not teach or suggest what is now claimed.

Claim 9 is herein amended to state that "non-valid passes issued to the participants are issued by an organiser of the event . . . a support organisation non-valid pass forms a second portion of a valid pass issu[ed] by the event organiser for distribution by . . . support organisations to selected ones of the participants associated with the respective support organisations . . . [wherein] the support organisation non-valid passes and the participant non-valid passes are issued in differing quantities, the quantity of support organisation non-valid passes being smaller than that of the participant non-valid passes." Claim 10 has been amended with similar language, according to the form of the invention it claims. No new matter is added in these amendments, since the specification as originally submitted provides support. Present application, page 5, line 26 - page 6, line 12.

The cited references do not teach or suggest what is now claimed. This feature of the invention is useful to enable an organizer to control the number of persons granted access to a controlled zone, while permitting the organizer to avoid the time consuming effort of determining exactly who will be granted access. For the above reasons, Applicant contends the invention set out in claims 9 and 10 is patentably distinct.

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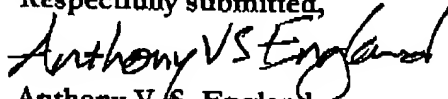
PRIOR ART OF RECORD

Applicant has reviewed the prior art of record cited by but not relied upon by Examiner, and asserts that the invention is patentably distinct.

REQUESTED ACTION

For the above reasons, Applicant contends the invention set out in claims 1 through 10 is patentably distinct. Applicant requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,



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